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EXAMINER

ANWAH, OLISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/01/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/033,289

Applicant(s)

LEWIS ET AL.

Examiner

Olisa Anwah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 5 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

1. Applicant submitted a statement stating the practitioner did not receive the Office action and that a search of the file jacket and the docket records of the application produced no evidence that the non-final Office action was received. Hence there is showing of non-receipt of the Office action.

Accordingly, the holding of abandonment is withdrawn.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-3, 6, 7, 13, 14 and 25-29 are rejected under 35 U.S.C. § 102(e) as being anticipated by Marino et al, U.S.

Patent No. 4,850,007 (hereinafter Marino).

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Regarding claim 1, Marino discloses a method for advertising-supported communications in a telecommunications network, the method comprising:

receiving a call request to connect a call from an originating subscriber terminal (11) to a destination subscriber terminal (directory assistance), the call request including a destination identifier (411) associated with the destination subscriber terminal (directory assistance) (col. 3, lines 1-15);

providing at least one advertisement to a subscriber associated with the originating subscriber terminal (col. 3, lines 60-67);

determining a free call balance for the subscriber based on the destination identifier and based on providing the at least one advertisement to the subscriber (col. 4, lines 15-20);

connecting the call from the originating subscriber terminal to the destination subscriber terminal (col. 4, lines 5-7); and

monitoring the free call balance as the call progresses (col. 4, lines 15-20).

Regarding claim 2, see Figure 1, unit 12.

Regarding 3, Marino discloses the method of claim 1, wherein determining the free call balance comprises:

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determining an advertisement time associated with the at least one advertisement being provided to the subscriber (col. 4, lines 53-55);

determining a number of credits of free call time based on the advertisement time being provided and determining a free calling time based on the number of credits of free calling time and the destination identifier (col. 4, lines 15-20).

Regarding claim 6, Marino discloses a method of claim 1 further comprising:

determining a discounted calling time for the subscriber based on the destination identifier and the at least one advertisement being provided to the subscriber (col. 4, lines 15-20); and

connecting the call from the originating subscriber terminal to the destination subscriber terminal (col. 4, lines 5-7);

monitoring the discounted calling time as the call progresses (col. 4, lines 15-20).

Regarding claim 7, Marino discloses the method of claim 1, wherein determining the free calling balance comprises:

determining an advertisement time associated with the at least one advertisement being provided to the subscriber (col. 3, lines 53-55);

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determining a credit value based on the advertisement time; and determining a free call time based on the credit value and the destination identifier associated with the destination subscriber terminal (col. 4, lines 15-20).

Regarding claims 13 and 14 see column 3.

Claim 25 is rejected for the same reasons as claim 1. The local telephone switching system is functionally equivalent to the first network entity. The advertising message system is functionally equivalent to the second network entity. The billing system is functionally equivalent to the third network entity.

Regarding claim 26, see col. 4, lines 15-20.

Claim 27 is rejected for the same reasons as claim 26.

Regarding the voice command platform see col. 4, from line 53 to line 55.

Regarding claim 28, see column 3.

Regarding claim 29, the subscriber test logic (23) contains a service controller that controls whether the advertising service is to be provided or not (see column 3).

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 8-12 and 15-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Marino in view of Nakamura, U.S. Patent No. 5,987,424 (hereinafter Nakamura).

Regarding claim 8, Marino does not disclose the limitation of decrementing the free calling balance as the call progresses, determining if the free calling balance reaches a predetermined threshold level and if so notifying the subscriber associated with the originating subscriber terminal. However Nakamura discloses the claimed limitation (col. 9, line 63 to col. 10, line 12). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Marino with the decrementing and determining methods taught by Nakamura. This modification allows a subscriber to make a call without having to pay any communication charges for the call.

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Regarding claims 9 and 10, see Nakamura, col. 32, lines 15-30.

Regarding claim 11, see Nakamura, col. 10, line 3.

Regarding claim 12, Marino as applied in claim 1 discloses the destination identifier associated with the destination subscriber terminal is a telephone number (col. 3, lines 7-8). Marino does not disclose the destination identifier associated with the destination subscriber terminal is selected from a group consisting of a mobile identification number, an IP address, an ENUM, a Network Access Identifier and a domain number. "Official Notice" is taken that mobile identification numbers, IP addresses, ENUMs, Network Access Identifiers and domain names are well-known destination identifiers associated with destination terminals. Therefore it would have been obvious to add these destination identifiers to the method for advertising-supported communications taught by Marino. This modification would allow a subscriber to dial destination numbers other than telephone numbers as suggested by Nakamura (col. 31, lines 63-65).

Regarding claim 15, Marino does not disclose the limitation of querying a subscriber associated with the originating subscriber terminal to specify an expected length of the call to be connected from the originating subscriber terminal to the



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destination subscriber terminal and providing the at least one advertisement based on the expected length of the call, wherein the at least one advertisement being provided to the subscriber is sufficient to connect the call for the specified length.

However Nakamura discloses the claimed limitation (see col. 32, lines 15-30). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Marino with the querying and providing methods as taught by Nakamura. This modification allows a subscriber to select the discount amount of a communication charge.

Regarding claim 16, Marino discloses a method for advertising supported communications in a telecommunications network, the method comprising receiving a call request to connect a call from an originating subscriber (11) terminal to a destination subscriber terminal (directory assistance), the call request including a destination identifier (phone number) associated with the destination subscriber terminal and further including a service code (additional digits), determining whether a subscriber associated with the originating subscriber terminal is designated to receive advertising supported services; if so, providing at least one advertisement to the subscriber (column 3), determining a free calling balance for the subscriber based on the destination identifier and based on

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providing the at least one advertisement to the subscriber (col. 4, lines 15-20), connecting the call from the originating subscriber terminal to the destination subscriber terminal (col. 4, lines 5-7), decrementing the free calling balance as the call progresses (col. 4, lines 15-20). The call is inherently disconnected when local telephone customer puts the local telephone (11) in the on hook position.

Marino does not disclose determining whether any unused free call balance is left; and, if so, discarding the any used free calling balance. However Nakamura discloses determining whether any unused free call balance is left; and if so, discarding the any unused free calling balance (col. 21, lines 40-48).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Marino with determining whether any unused free call balance is left; and, if so, discarding the any unused free calling balance as taught by Nakamura. This modification allows for the discount to be rendered invalid when the next billing month is entered as suggested by Nakamura (col. 21, lines 40-48).

Regarding claim 17, see Marino unit 12.

Regarding claim 18, see Marino, col. 3, line 32.

Regarding claim 19, Marino discloses the method of claim 16, wherein determining whether a subscriber associated with the

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originating subscriber terminal is designated to receive advertising supported services comprises:

retrieving a subscriber record associated with the subscriber of the originating subscriber terminal and determining whether the subscriber record designates the subscriber to receive the advertising supported services (col. 3, lines 15-25).

Claim 20 is rejected for the same reasons as claim 12.

Regarding claim 21, see Marino, col. 3, lines 60-67.

Regarding claim 22, see Marino, col. 4, lines 1-5.

Regarding claim 23, Marino discloses the method of claim 16, further comprising:

determining a discounted calling time for the subscriber based on the destination identifier and the at least one advertisement being provided to the subscriber (col. 4, lines 15-20);

connecting the call from the originating subscriber terminal to the destination subscriber terminal (col. 4, lines 5-7);

decrementing the discounted calling time as the call progresses (col. 4, lines 15-20).

Regarding claim 24, see col. 32, lines 15-30.

***Allowable Subject Matter***

6. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

7. Applicant argues Marino fails to teach the function of determining a free calling balance based on a destination identifier. However Marino discloses, "after an advertisement is played to a subscriber, a reduced rate billing and/or credit is accumulated and is sent with the customer's monthly bill to his home" (col. 4, lines 15-20). A customer's monthly bill is based on a customer's dialed destination identifiers and Marino teaches presenting a credit along with bill after an advertisement is played. Hence Marino's free calling balance is not only based on the advertisement, the free calling balance also depends on the dialed destination identifiers.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 703-305-4814. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

O.A.

Olisa Anwah  
Patent Examiner  
April 9, 2003

FAN TSANG  
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